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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,622	10/20/2003	Howard Tanner	23660-00610	4684

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KELLEY DRYE & WARREN LLP
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EXAMINER

WOO, JULIAN W

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,622

Applicant(s)

TANNER ET AL.

Examiner

Julian W. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 75-77 and 96-112 is/are pending in the application.
- 4a) Of the above claim(s) 106, 107, 111 and 112 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 75-77, 96-105 and 108-110 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 75-77, 96-102, and 108-112 in the reply filed on September 5, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). However, the Applicant's election and amendment did not include an election of species for Group I. Upon further consideration of the elected claims, the Examiner has determined that the application contains claims directed to the following patentably distinct species as shown in the figures:

Species 1: Figures 32B and 32C

Species 2: Figures 25-28.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 75-77, 108, and 109 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations

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of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

3. During a telephone conversation with Ronald Kimble, Reg. No. 44,186, on October 27, 2006, a provisional election was made without traverse to prosecute the invention of claims 75-77, 96-105, and 108-110. Affirmation of this election must be made by applicant in replying to this Office action. Claims 106, 107, 111, and 112 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

5. Claims 76, 77, 97-105, 109, and 110 are objected to because of an informality, which can be corrected as follows: In each of these claims, "The fastener" should be replaced by –The fastener assembly--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 75-77, 96-105, and 108-110 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to base claims 75 and 108, it is not certain whether the "surgical component" is a structural part of the invention; and the "vessel," an unpatentable part of the human body, is essentially claimed as a structural part of the invention (where the "second portion" is said to be "located...on one side of the vessel"). Also, with respect claim 96, the first and second portions are said to extend "substantially parallel to the vessel wall," where the "vessel wall," an unpatentable part of the human body, is essentially claimed as structural part of the invention. Also with respect to claims 97-99, "said second configuration" lacks antecedent basis.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 75-77, 96, 100-105, and 108-110 are rejected under 35 U.S.C. 102(b) as being anticipated by Marks (5,108,420). Marks discloses, at least in figures 6-9 and in col. 5, line 18 to col. 6, line 22; a fastener assembly including flexible fastening

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assembly including opposing first and second portions (62a, 62b) that are drawn together by application of a compressive force, where the fastening assembly is a spring assembly, which is a manipulated coil spring; where the first and second portions are extendable substantially parallel to a vessel wall, where the first and second portions comprise an axially wound or a radially wound portion, and where the first and second portions are disposed on a coil portion. Note: The introductory statement of intended use ("for use during a surgical procedure for securing a surgical component to a vessel") has been carefully considered but deemed not to impose any structural limitations on the claims patentably distinguishable over Marks' device, which is capable of being used as claimed if one desires to do so.

10. Claims 75 and 97-99 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleischman et al. (6,132,438). Fleischman et al. disclose, at least in figures 29 and 31A-31C, a fastener assembly including flexible fastening assembly including opposing first and second portions (116, 117 or 116 and 126) that are drawn together by application of a compressive force, where each of the first and second portions (116 or 117) is formable into a semi-knotted (i.e. looped) portion. If the second portion is deemed element 126, a suture, then element 126 is semi-knotted when attached to 117). Note: The introductory statement of intended use ("for use during a surgical procedure for securing a surgical component to a vessel") has been carefully considered but deemed not to impose any structural limitations on the claims patentably distinguishable over the device of Fleischman et al., which is capable of being used as claimed if one desires to do so.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lawyer (568,030), Hirata (5,501,700), and Evard et al. (6,616,675) teach fastener assemblies.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is 571-272-4707. The examiner can normally be reached on M-F, 6:30-4:00, Alt. Fri. OFF, 6:30-3:00 Fri. IN.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Julian W. Woo
Primary Examiner
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October 28, 2006